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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,117	12/02/2003	Hanns-Joerg Mauk	0324	3331
112	7590	06/08/2006		
ARMSTRONG WORLD INDUSTRIES, INC. LEGAL DEPARTMENT P. O. BOX 3001 LANCASTER, PA 17604-3001				
EXAMINER SIMONE, CATHERINE A				
ART UNIT		PAPER NUMBER		
1772				

DATE MAILED: 06/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/725,117

Applicant(s)

MAUK ET AL.

Examiner

Catherine Simone

Art Unit

1772

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 May 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 24 May 2006. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Attachment.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

ADVISORY ACTION

Response to Arguments

Applicant's arguments filed 5/24/06 have been fully considered but they are not persuasive.

Applicants argue "Eiden is concerned about removing dirty liquids. The present invention is directed to repelling dirt from the surface with a substance that is incompatible with the matrix of the floor covering and that migrates to the surface of the floor covering. See paragraphs 0014 and 0015 of the specification. The elevations and recesses specified in claim 1 improve this dirt-repelling behavior. See paragraphs 0050 to 0053 of the specification. Therefore, while both Eiden and the present invention are both directed to the general category of improving soiling behaviors, the soiling behaviors addressed are quite different and optimizing the conditions for the one does not necessarily optimize the conditions for the other". Applicants further argue "since person having ordinary skill would be modifying the invention of Eiden, it is the purpose of Eiden that he would be optimizing. Unless that is some reason to contradict the teachings of Eiden, one must assume that optimizing the ranges of Eiden would yield his preferred difference in height between the elevations and the recesses of 1.3 to 2.0 mm and the spacing between peaks of 25 mm. These ranges fall outside those claimed in present claim 1".

First, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "*repelling dirt from the surface* with a substance that is incompatible with the matrix of the floor covering and that migrates to the surface of the floor covering" and "the elevations and recesses...improve

this dirt-repelling behavior”) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Secondly, as pointed out by the Applicants, both Eiden and the present invention are directed to the general category of improving soiling behaviors. Therefore, the optimum ranges for the average spacing between the peaks in the centerline and the difference in height between the elevations and the recesses would be readily determined through routine experimentation by one having ordinary skill in the art depending on the desired end results. Thus, it would have been obvious to one of ordinary skill in the art at the time the applicant’s invention was made to have modified the elevations and recesses of the floor covering in Eiden to have an average spacing between profile peaks in the centerline being more than about 200 μm and less than about 1000 μm , and have the difference in height between the elevations and the recesses being from about 20 μm to about 200 μm , since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art in absence of showing unexpected results. *MPEP 2144.05 (II)*.

Applicants then argue “while the phrase “at room temperature” does not appear, *ipsis verbis*, in the specification, paragraph 0015, as filed, states “at least one substance migrates slowly, but continuously from the floor covering to the surface of the floor covering and thus forms a continuously renewing protection, even when the substance migrating to the surface is worn or abraded off by walking on the floor covering.” The “substance migrates...continuously...even when...the surface is worn or abraded off by walking on the floor covering.” Since the floor covering is walked on at room temperature, the substance, which

migrates continuously, migrates at room temperature and the phrase “at room temperature” is supported by the specification, as filed”.

However, the phrase “at room temperature” clearly does not appear in the specification and is not clearly supported by the specification, as originally filed. Therefore, the phrase “at room temperature” in claim 26 is still deemed new matter.

Applicants then argue “there is no teaching in Marchal as to what the plasticizer content in the plastisol is.” However, the floor covering in Marchal includes 100 parts of PVC plastisol (see page 3, lines 20-23) and since it is made up of PVC, the floor covering inherently has a plasticizer being in an amount of at least 12 wt% based on the PVC.

Applicants further argue “Marchal does not teach a homogenous floor covering....the invention of Marchal is directed to a floor covering having a plastisol wear layer and a support”. However, according to *Merriam-Webster's Collegiate Dictionary, tenth edition*, “homogenous” is defined as “homogeneous” which is defined as “of uniform composition or structure throughout”. The floor covering in Marchal is made up of a PVC plastisol wear layer, which is of uniform composition throughout, (see col. 1, lines 36-40) and is therefore homogenous. Thus, Marchal clearly teaches a homogenous floor covering.

Applicants then argue “there is no teaching or suggestion in the cited passages or anywhere else in Hiragami of the particles or any other component migrating”.

First, it is to be pointed out that it has been held that a recitation that an element is “capable of” performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. Secondly, the particles in the composition of the floor covering in Hiragami clearly are capable of migration (see Fig. 1,

element 2' and col. 3, lines 6-9 and 16-19). Therefore, Hiragami clearly teaches a substance capable of migration as recited in claim 26.

Applicant further argues "Hiragami does not teach a homogenous floor covering". However, according to *Merriam-Webster's Collegiate Dictionary, tenth edition*, "homogenous" is defined as "homogeneous" which is defined as "of uniform composition or structure throughout". The floor covering in Hiragami is made up of a PVC matrix layer, which is of uniform composition throughout, (see col. 1, lines 57-68) and is therefore homogenous. Thus, Hiragami clearly teaches a homogenous floor covering.

In response to applicant's argument that there is no suggestion to combine the Berenger reference with either the Marchal or Hiragami reference, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Marchal and Hiragami each clearly teaches a flooring covering having a composition including a PVC binder, a plasticizer and a substance capable of migration as presently claimed. Berenger was merely cited for suggesting that it is old and well-known in the art to have a PVC coating wherein the PVC has a K-value between 55 and 85 (see col. 3, lines 27-29) for the purpose of manufacturing a floor covering with a plastic surface finish which is much glossier, thereby in particular dispensing with any application of one or more surface varnishes. Thus, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have

modified the PVC of the PVC coating in either Marchal or Hiragami et al. to have a K-value from about 40 to about 80 as suggested by Berenger in order to form a floor covering with a plastic surface finish which is much glossier, thereby in particular dispensing with any application of one or more surface varnishes. One skilled in the art would clearly be able to modify the PVC in either Marchal or Hiragami to have a K-value from about 40 to about 80, if so desired.

Applicant further argues "Kondo does not teach or suggest that the wax-like substances migrate at room temperature. In fact, Kondo teaches away from the present invention." However, Kondo clearly teaches the wax-like substances migrating at room temperature (see page 4, lines 11-15). Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified the substance capable of migration in the wear layer of the floor covering in either Marchal or Hiragami to be a wax-like substance selected from the group consisting of a partially synthetic wax, a fully synthetic wax, a natural wax, a modified natural wax and mixtures thereof as suggested by Kondo et al. in order to improve lubricity as well as flaw resistance, stain resistance and abrasion resistance.


Furthermore, Applicant argues "Apikos teaches away from the present invention....Apikos teaches that higher concentrations, which lead to migration and an unattractive coating appearance, must be avoided". However, Apikos was merely cited to teach that it is old and well-known in the art to have an amide wax as a substance capable of migration (see col. 2, lines 49-55) in a surface layer for the purpose of providing temporary surface protection against abrasion, dirt and other damage occurring in storage and handling. Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention

was made to have modified the substance capable of migration in the surface layer of the floor covering in either Hiragami or Marchal to be an amide wax as suggested by Apikos in order to provide temporary surface protection against abrasion, dirt and other damage occurring in storage and handling.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine Simone whose telephone number is (571)272-1501. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Catherine A. Simone
Examiner
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June 2, 2006


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1772

6/6/06